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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PING-WEN ONG

Appeal 2009-004853
Application 09/201,749
Technology Center 3600

Decided: January 25, 2010

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1-3, 5-10, 12-18, 20-24, and 26-28[1]. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented systems and methods for providing persistent storage of Web resources by augmenting Uniform Resource Locators ("URLS") to include a time stamp (Abstract).

Claim 1 under appeal is further illustrative of the claimed invention as follows:

> 1. A method for providing an electronic document, said electronic document having multiple versions, each of' said versions identified by a creation time-stamp indicating a creation time of' said corresponding version, said method comprising the steps of:
>
> receiving a request for said electronic document, said request including a requested time-stamp indicating a time associated with a desired version of said electronic document and a requested domain name associated with said time-stamp;
>
> identifying as a function of said creation time-stamp and said requested time-stamp a desired version of said electronic document having a creation time corresponding to said requested time-stamp; and
>
> identifying an address of' said desired version of' said electronic document stored on a server corresponding to said requested time-stamp as a function of' said requested timestamp and said requested domain name, wherein a server identified by said requested domain name does not provide said desired version at a time of said request and said identified server has a redirected domain name that is different than said requested domain name.

[1] Claims 4, 11, 19, and 25 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 29-35 are withdrawn from consideration.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

KANFI	US 5,559,991	Sept. 24, 1996
AMSTEIN	US 5,793,966	Aug. 11, 1998

The Examiner rejected claims 1, 6, 8, 12, 15, 16, 20, 22, 26, and 28 under 35 U.S.C. § 112, second paragraph, for indefiniteness; rejected claims 1-3, 5-7, 9, 10, 12-16, 18, 20-24, and 26-28 under 35 U.S.C. § 103(a) as being unpatentable over Amstein; and rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Kanfi in view of Amstein.

We AFFIRM-IN-PART.

ISSUES

Did the Appellant show the Examiner erred in rejecting claims 1, 6, 8, 12, 15, 16, 20, 22, 26, and 28 under 35 U.S.C. § 112, second paragraph, for indefiniteness?

Did the Appellant show the Examiner erred in asserting that the updated document meta information file of Amstein corresponds to "wherein a [server/machine] identified by said requested domain name does not provide said desired version at a time of said request and said identified server has a redirected domain name that is different than said requested domain name," as recited in independent claims 1, 8, 15, 16, 22, and 28?

FINDINGS OF FACT

Specification

Appellant invented systems and methods for providing persistent

storage of Web resources by augmenting Uniform Resource Locators ("URLS") to include a time stamp (Abstract).

Amstein

Amstein discloses computer systems for creating, developing, and/or modifying on-line services in a client-server information system (col. 1, ll. 9-11).

Each web or service has a location 400 on the server where all the document objects and associated information of the web is stored (col. 17, ll. 33-35).

Meta-information, or information about information, is also stored. First, document meta-information, or information about a particular web document object, such as the title of the document, the author of the document, the date and time that the document was created, and the date and time that the document was last modified, may be stored in another location 406 on the server. The document meta-information may also include a list of hypertext links from the document to other document objects (col. 17, ll. 55-63).

The attribute "vti_cachedbasedtm" gives the date and time of last modification to any of the cached attribute values, in this case "19 Nov. 1995 10:47:2 EST". The attribute "vti_cachedtitledtm" gives the date and time of last modification to the "vti_cachedtitle" attribute value, in this case "19 Nov. 1995 10:47:50 EST". The attribute "vti_cachedlinkedinfo" gives the list of document that this document links to, in this case the first link is to "images/logo.gif". The attribute "vti_cachedlinkedinfotm" gives the date and time of last modification to the "vti_cachedlinkedinfo" attribute value,

in this case, "19 Nov. 1995 10:47:42 EST". The attribute "vti_timelastmodified" gives the time at which the document was last modified, in this case "19 Nov. 1995 10:47:33 EST". The attribute "vti_timecreated" gives the time at which the document was created, in this case "19 Nov. 1995 10:47:33 EST" (col. 19, ll. 28-47).

The attribute "vti_autorecalc" indicates whether the server extension program must automatically recalculate document dependencies after a document object is saved to the server (col. 20, ll. 13-16).

The document meta information file is updated as follows. The value of the "vti_timelastmodified" attribute is changed to the current time, to indicate the time at which the document was last modified. The value of the "vti_cachedlinkinfo" attribute is changed to be the current list of documents or images that the current document either includes or has links to, so that the list reflects any additions or deletions of links in the new version of the document. The value of the "vti_cachedlinkinfodtm" attribute is changed to the current time, to indicate the time at which the value of the "vti_cachedlinkinfo" attribute was last updated. The value of the "vti_cachedtitledtm" attribute is changed to the current time, to indicate the time at which the value of the "vti_cachedtitle" attribute was last updated. The attribute "vti_cachedbasedtm" is changed to the current date and time, indicating the most recent modification to any of the cached attribute values. The attributes "vti_timecreated" and "vti_author" are not changed, since these give information about the creation of the document. After meta-information is updated, the document dependency database and the text index of all documents in the web are both updated to reflect the changes in the saved document (col. 24, ll. 31-64).

PRINCIPLES OF LAW

Claim Construction

The context of the surrounding words of the claim must be considered in determining the ordinary and customary meaning of those terms. *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003).

Indefiniteness

A claim is definite if "one skilled in the art would understand the bounds of the claim when read in light of the specification." *Personalized Media Communications, LLC v. ITC*, 161 F.3d 696, 705 (Fed. Cir. 1998).

Breadth is not indefiniteness. *In re Gardner*, 427 F.2d 786, 788 (CCPA 1970).

If a claim is subject to two interpretations as the examiner suggests is the case here and one interpretation would render the claim unpatentable over the prior art, we believe the proper course of action is for the examiner to enter two rejections: (1) a rejection based on indefiniteness under 35 U.S.C. §112, second paragraph, and (2) a rejection over the prior art based on the interpretation of the claims which renders the prior art applicable. Entry of simultaneous rejections avoids piecemeal appellate review. *Ex parte Ionescu*, 222 USPQ 537, 540 (Bd. Pat. App. & Int. 1984) (citing, e.g., *In re Marosi*, 710 F.2d 799 (Fed. Cir. 1983); *Tofe v. Winchell*, 645 F.2d 58, (CCPA 1981); *Stratoflex, Inc., v. Aeroquip Corp*., 713 F.2d 1530, 218 USPQ 871 (Fed.Cir. 1983)).

Obviousness

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)

During examination, the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

Indefiniteness

We are persuaded of some error on the part of the Examiner by Appellant's argument that claims 1, 6, 8, 12, 15, 16, 20, 22, 26, and 28 are not indefinite under 35 U.S.C. § 112, second paragraph (App. Br. 7; Reply Br. 2-4).

The Examiner asserts that there is insufficient antecedent basis for the multiple recitations of "a time" in independent claims 1, 8, 15, 16, 22, and 28 (Examiner's Ans. 4-5, 10-11). However, the multiple recitations of "a time" are not read in a vacuum, but must be considered in the context of the rest of the claim. *See ACTV, Inc. v. Walt Disney Co.*, 346 F.3d at 1088. Taken in context, the multiple recitations of "a time" are not indefinite because each recitation of "a time" is followed by what the time is associated with. For example, independent claim 1 recites "a time associated with a desired version of said electronic document" and "a time of said request." Accordingly, one of ordinary skill in the art would understand how each recitation of "a time" differs from the others. *See*

Personalized Media Communications, LLC v. ITC, 161 F.3d at 705. A similar analysis can be applied to independent claims 8, 15, 16, 22, and 28.

By contrast, the same analysis does not hold true for the multiple recitations of "a desired version" in independent claims 1, 8, and 15. Here, the second recitation of "a desired version" in the paragraph beginning with "identifying as a function" is the same as the recitation of "a desired version" in the paragraph beginning with "receiving." Indeed, Appellant admits that "one or more of the instances of a desired versions may identify the same document" (App. Br. 7). The use of "may" injects ambiguity that makes the terms indefinite. Accordingly, either the second recitation of "a desired version" should be "said desired version," as set forth in the paragraph beginning with "identifying an address" as recited in independent claim 1, or "a desired version" should be named something else if it truly is different from the first desired version.

The recitation of "a time" in independent claims 1, 8, 15, 16, 22, and 28 is not indefinite because "a time" could mean any time such as "a minute or a second or an hour or a day or a week or a month or a year" (Ex. Ans. 11). One of ordinary skill understands that "a time" could be in any of these units, but that a specific time using whichever units would still be required (e.g., "19 Nov. 1995 10:47:33 EST"). *See Personalized Media Communications, LLC v. ITC*, 161 F.3d at 705. The fact that "a time" could be broad does not render it indefinite. *See In re Gardner*, 427 F.2d at 788.

The Examiner asserts that "said request" in "said request is specified using a browser," as recited in dependent claims 6, 12, 20 and 26, is indefinite because it is unclear which "request" in respective independent claims 1, 8, 15 and 22 is being referenced (Examiner's Ans. 7, 11).

However, independent claims 1, 8, 15 and 22 each recite "a request for said electronic document," with the "requested time-stamp" and "requested domain name" being subsets of the "request." Accordingly, independent claims 1, 8, 15 and 22 each recite only one "request."

Desired Version

While certain aspects of independent claims 1, 8, and 15 are not completely clear, in the interest of judicial economy, we will review the prior art rejections. For this purpose, we construe the second recitation of "a desired version" as being "said desired version."

We are persuaded of error on the part of the Examiner by Appellant's argument that the updated document meta information file of Amstein does not correspond to "wherein a [server/machine] identified by said requested domain name does not provide said desired version at a time of said request and said identified server has a redirected domain name that is different than said requested domain name," as recited in independent claims 1, 8, 15, 16, 22, and 28 (App. Br. 8-11, Reply Br. 3, 5-8). Amstein discloses electronic documents including meta-information containing various time data related to the creation and modification of a *current* version of the electronic document. However, the recited "desired version" of the electronic document is a version *previous to* the current version of the electronic document. This is recited in the independent claims as the server/machine "does not provide said desired version at a time of said request." In other words, the desired version is not the version that is current at the time of said request. The portions of Amstein cited by the Examiner do not disclose

providing a version of an electronic document previous to the current version.

Furthermore, the Examiner admits that "Amstein did not expressly disclose that the server is identified by the requested domain name" (Examiner's Ans. 6). Thus, the Examiner admits that Amstein does not disclose that "said identified server has a redirected domain name that is different than said requested domain name," as recited in independent claims 1, 8, 15, 16, 22, and 28. The Examiner then asserts that "Amstein discusses a server in col. 20, lines 13-16 which could be used to perform this step in claim 1," and that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the server being identified by the requested domain name with the identified server having a redirected domain name because such feature would make the web pages (HTML files) available to be viewed by the web browser at a redirected web site on the Internet" (Examiner's Ans. 6-7). However, these are mere conclusory statements that modifying Amstein would result in the aforementioned recitation of independent claims 1, 8, 15, 16, 22, and 28, without the required articulated reasoning with rational underpinnings as to why one of ordinary skill would modify Amstein to include these recitations. *See In re Kahn*, 441 F.3d at 988. Accordingly, as the Examiner has not provided a proper case of prima facie obviousness, we will not sustain the rejections of independent claims 1, 8, 15, 16, 22, and 28, and the rejections of their dependent claims 2, 3, 5-7, 9, 10, 12-14, 17, 18, 20, 21, 23, 24, 26, and 27.

CONCLUSION OF LAW

On the record before us, Appellant has shown that the Examiner erred in rejecting claims 6, 12, 16, 20, 22, 26, and 28 under 35 U.S.C. § 112, second paragraph.

On the record before us, Appellant has not shown that the Examiner erred in rejecting claims 1, 8, and 15 under 35 U.S.C. § 112, second paragraph.

On the record before us, Appellant has shown that the Examiner erred in rejecting claims 1-3, 5-10, 12-18, 20-24, and 26-28 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 2, 3, 5-7, 9, 10, 12-14, 16-18, 20-24, and 26-28 is reversed.

The decision of the Examiner to reject claims 1, 8, and 15 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

MP

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